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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/980,192 | 04/15/2002 | Jean-Pierre Molitor | H 4156 PCT/US | 1132 |
| 23657 | 7590 | 07/16/2004 | EXAMINER | |
| COGNIS CORPORATION PATENT DEPARTMENT 300 BROOKSIDE AVENUE AMBLER, PA 19002 | | | MARX, IRENE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1651 | |

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,192

Applicant(s)

MOLITOR ET AL.

Examiner

Irene Marx

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) 21-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Applicant's election with traverse of Group I, claims 11-20 on May 13/04 is acknowledged.

The traversal is on the ground(s) that the examiner has not specifically listed the groups, described the unique special technical feature in each group and that the question should be whether the same technical feature is contained in each group and not whether the special technical feature actually makes a contribution over the art. However, applicant has not cited a suitable authority to substantiate the statements made.

As noted in the last Office action, the claims in Group I are 11-20 and in Group II are 21-32. With respect to the contribution of the special technical feature, in MPEP 1893.03(d) and 37 CFR 1.499 the statements relating to unity of invention during the national stage are:

"A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. The expression special technical features is defined as meaning **those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art.** For example, a corresponding technical feature is exemplified by a key defined by certain claimed structural characteristics which correspond to the claimed features of a lock to be used with the claimed key." (emphasis added).

As noted in the restriction requirement, the invention as claimed does not define a contribution over the art.

For these reasons, the restriction requirement is deemed proper and is adhered to. The restriction requirement is hereby made FINAL.

Claims 21-32 are withdrawn from consideration as directed to a non elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 18-20 are confusing and inconsistent in the recitation of “by weight based on the microemulsion” and “by weight based on the total weight of the microemulsion”. The basis for the two different standards of weight measurement is unclear. Is the emulsion formed prior to the addition of the emulsifier?

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Tellier *et al.* (U.S. Patent No. 4,401,762).

The claims are directed to a reaction medium comprising a microorganism and a microemulsion, wherein the microemulsion comprises water, an emulsifier and an oil phase. The oil phase may be a fatty acid alkyl ester or a vegetable triglyceride

The cited reference discloses a reaction medium comprising a microorganism and a microemulsion, wherein the microemulsion comprises water, an emulsifier and an oil phase for the degradation of hydrocarbons. The oil phase may be a fatty acid alkyl ester or a vegetable triglyceride. See, e.g., Table in col. 11, wherein at least the vegetable oils, sesame oil and colza oil from rapeseed, as well as various alkyl esters, including methyl oleate, are used.

Therefore, the invention is anticipated by the reference.

Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tellier *et al.* (U.S. Patent No. 4,401,762) taken with Brenkman *et al.* (U.S. Patent No. 5,674,830).

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The claims are directed to a reaction medium comprising a microorganism and a microemulsion, wherein the microemulsion comprises water and emulsifier and an oil phase. The oil phase may be a fatty acid alkyl ester or a vegetable triglyceride

As indicated in the rejection under 35 U.S.C § 102, *supra*, Tellier *et al.* disclose a reaction medium comprising a microorganism and a microemulsion, wherein the microemulsion comprises water, an emulsifier and an oil phase for the degradation of hydrocarbons. The oil phase may be a fatty acid alkyl ester or a vegetable triglyceride. See, e.g., Table in col. 11, wherein at least the vegetable oils sesame oil and colza oil from rapeseed, as well as various alkyl esters, including methyl oleate are disclosed.

The references differ from the claimed invention in that alkyl glycosides are not specifically indicated as suitable emulsifiers. However, Brenkman *et al.* adequately demonstrate that alkyl glycosides are known in the art for the production of microemulsions (See, e.g., Examples)

The ranges of ingredient content discussed in the references appear to be substantially the same as claimed. However, even if they are not, the adjustment of the amounts used in the reaction medium preparation for optimization purposes identified as result-effective variables cited in the references would have been *prima facie* obvious to a person having ordinary skill in the art, since such adjustment is at the essence of biotechnical engineering.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to modify the reaction medium of Tellier *et al.* by substituting an alkyl glycoside for another emulsifier, as suggested by the teachings of Brenkman *et al.*, since the expected effects would be equivalent. In addition, the modification of altering the proportions of the various ingredients for optimization purposes would have been obvious to one of ordinary skill in the art, for the expected economic benefit of enhancing the bioavailability of the lipids to recalcitrant microorganisms in microemulsions to support the growth and proliferation of these microorganisms, as well as providing the option of not having to filter-sterilize the lipid fraction and the rest of the media components separately. The enhanced growth and proliferation of recalcitrant microorganism using such microemulsions has the expected benefit of increasing the yields of pharmaceutically and industrially important metabolites and/or aiding in the identification of pathogenic microorganisms.

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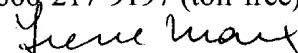
Thus, the claimed invention as a whole was clearly *prima facie* obvious, especially in the absence of evidence to the contrary.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (571) 272-0919. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on (571) 272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Irene Marx
Primary Examiner
Art Unit 1651